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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,736	02/02/2001	Hirokazu Kubota	Q62542	6936

7590 12/30/2004

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EXAMINER

RAO, DEEPAK R

ART UNIT	PAPER NUMBER
1624	

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/773,736

Applicant(s)

KUBOTA ET AL.

Examiner

Deepak Rao

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/4/04 & 12/16/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-6,8-10,15,16,18,19,28-31,35-38,42 and 43 are pending in the application.
- 4a) Of the above claim(s) 8 and 18 are withdrawn from consideration.
- 5) ☒ Claim(s) 37 is/~~are~~ allowed.
- 6) ☒ Claim(s) 1,10,30 and 31 are rejected.
- 7) ☒ Claim(s) 4-6,9,15,16,19,28,29,35,36,38,42 and 43 are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

This office action is in response to the amendments filed on October 4 and December 16, 2004.

Claims 1, 4-6, 8-10, 15-16, 18-19, 28-31, 35-38 and 42-43 are pending in this application.

#### ***Withdrawn Rejections/Objections:***

Applicant is notified that any outstanding rejection/objection that is not expressly maintained in this office action has been withdrawn or rendered moot in view of applicant's amendments and/or remarks.

#### ***Inventorship***

In view of the papers filed on October 4, 2004, the inventorship in this nonprovisional application has been changed by the deletion of YOSHINORI OKAMOTO.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

#### ***Election/Restrictions***

The application was examined around the elected species of Example 1, namely 4'-[3,5-bis(trifluoromethyl)-1H-pyrazol-1-yl]-4-methylthiazole-5-carboxamide, i.e., formula (I) wherein D is 1H-pyrazol-1-yl; B is 1,4-phenylene; X is -NH-CO- and A is as

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defined in the claims, and the art found was applied in the previous office action.

Applicant's amendment overcomes the rejection under 35 U.S.C. 102 of the previous office action. As per the guidelines of MPEP § 803.02, the search was expanded to compounds of formula (I) wherein D is 1H-pyrazol-3-yl; B is 1,4-phenylene; X is -NH-CO- and A is as defined in the claims, and art was found.

The guidelines of election of species in MPEP § 803.02 provide that:

As an example, in the case of an application with a Markush-type claim drawn to the compound C-R, wherein R is a radical selected from the group consisting of A, B, C, D and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD or CE. The Markush-type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the non-elected species would be held withdrawn from further consideration. As in the prevailing practice, a second action on the merits on the elected claims would be final.

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.

Accordingly, claims 8 and 18 (wherein D is 1H-pyrazol-5-yl); and the generic subject matter of D, B and X other than as indicated above of the remaining pending claims, is withdrawn from consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 10, 30 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Cacchi et al., Synlett (August 1997) (the corresponding CAPLUS Abstract 127:293164, 1997 is enclosed herewith). The instant claims read on reference disclosed compound, see the compound of RN 197093-26-8 in the CAPLUS Abstract.
2. Claims 1, 10, 30 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Sykulski et al. (CAPLUS Abstract 91:74524, 1979). The instant claims read on reference disclosed compound, see the compound of RN 70958-31-5 in the CAPLUS Abstract.

***Allowable Subject Matter***

Claims 4-6, 9, 15-16, 19 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form **limited to the examined subject matter indicated above** and including all of the limitations of the base claim and any intervening claims.

Claims 28, 29, 35, 36, 42 and 43 are objected to for containing non-elected subject matter but would be allowable if rewritten **limiting to the examined subject matter indicated above**.

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Claim 37 is allowed. The references of record do not teach or fairly suggest the instantly claimed compound.

**Note:** Applicant's attention is directed to U.S. Patent No. 6,140,509 which while is not competent references against the instant claims, claims compounds that are structurally analogous to the instant claims, see the claim wherein the phenyl ring is in 1,3-relation ship with the pyrazole and the carboxamide groups (the corresponding compounds in col. 34-35). The instant claims recite that group B is 1,4-phenylene. Unless applicants can demonstrate that the instant claims are patentably distinct from the claim in this US patent, the only way to overcome this patent is by way of interference proceedings or removal of the conflicting subject matter. See MPEP § 2306.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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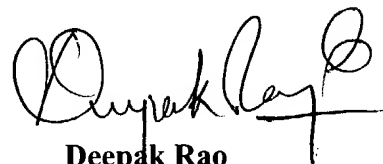
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672.

The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah, can be reached on (571) 262-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting-SPE of 1624 at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Deepak Rao**  
**Primary Examiner**  
**Art Unit 1624**

December 29, 2004